

**RESPONSE TO EXAMINER'S REJECTIONS/REMARKS**

Responsive to the Office Action mailed February 4, 2005. Applicant thanks the Examiner for his guidance and has amended the claims to address the office action. In the present response, the Applicant has amended independent claims 1 and 15. Applicant has withdrawn dependant claims 10-11 and 22-23.

The Applicant has incorporated the limitations found in withdrawn claims 10-11 and 22-23 into each of the independent claims. The Examiner has rejected Claims 11-12 and 22-23 under 35 U.S.C. 103(a) as being unpatentable over Schmitman in view of Menard, et al. However, Schmitman does not teach transfer of heat through a hull region to the ambient water.

Applicant respectfully submits that the references cited above fail to teach the elements of the present application. A PEMFC is not an engine as taught in Menard, et al. Also, in both Schmitman and Menard, et al., the references lack the suggestion or motivation to combine the references. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. MPEP 2403.01.

No explicit motivation to combine exists in the references. The MPEP instructs that, "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also, MPEP 2403.01.

In the present case, Schmitman seeks to use fuel cell "waste heat" to perform other work aboard a ship such as water generation Col. 6 lines 50-51. Schmitman teaches away from removal of heat from the ship or removal of heat to the marine environment through a heat exchange region of the hull.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). See also, MPEP 2143.03. Additionally, the Schmitman and Menard references, when combined, do not teach a heat exchange region of a hull for the transfer heat produced by the PEMFC to the marine environment. Rather, Menard, et al. teaches an exchange of heat from a cooling fluid to the marine environment. Thus, Applicant respectfully submits that Menard and Schmitman do not establish a *prima facie* case of obviousness.

It is also well established, that if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). See also, MPEP 2143.03. Accordingly all claims depending from the independent claims are not obvious in Schmittman over Menard, et al.

Thus, Applicant respectfully requests that the Examiner also withdraw these rejections as to Claims 2-9 and 12-14, 16-21 and 24.

### Conclusion

Applicant has complied with all requirements made in the above-referenced communication. In view of the foregoing, it is respectfully submitted that the pending Claims in the application are in condition for allowance. Allowance of the pending claims at an early date is courteously solicited.

If, for any reason, the Examiner finds the application other than in condition for allowance, the Examiner is respectfully requested to call Applicant's undersigned representatives, attention Mark Krietzman at (310) 586-7788 to discuss the steps necessary for placing the application in condition for allowance.


Amdt. Dated May 20, 2005  
Reply to Office Action of Feb. 4, 2005

This response is being timely filed and no fee is believed due. However, if Applicant is mistaken, the Commissioner is hereby authorized to charge any required fee in connection with the submission of this paper, now or in the future, or credit any overpayment to Account No. 50-2638. Please ensure that the Attorney Docket Number is referred to when charging any payments or credits for this case.

Respectfully submitted,

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